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PATENT
Customer No. 22,852
Attorney Docket No. 06843.0091

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re new National Stage Application of:)
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Peter J. RATCLIFFE et al.) Group Art Unit: 1656
)
Application No.: 10/531,662) Examiner: Alexander D. Kim
)
Filed: April 15, 2005)
)
For: HYDROXYLASES AND) Confirmation No.: 4806
MODULATORS THEREOF)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In an Office Action dated April 20, 2007, the Examiner required restriction under
35 U.S.C. §§ 121 and 372 between three groups:

Group I. Claims 1, 3-6, 29-33, drawn to a method of identifying, screening, characterizing, or designing a chemical entity comprising comparing a structural model of FIH with a structural model of the chemical entity.

Group II. Claims 7-25, drawn to a chemical entity identified by a method of Group I, which inhibits asparaginyl hydroxylase activity.

Group III. Claims 27-28, drawn to a method of treatment of a condition associated with increased or decreased HIF levels.

It is the Examiner's belief that the groups are unrelated because the chemical entity of Group II is different from the technical feature of the method of Group I, and the Group III method has different steps compared to the method of Group I. Office Action at 3. Applicants respectfully traverse.

Applicants refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs the Examiner as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added). In the instant case, the Examiner has not demonstrated that examining Groups I-III together would constitute a serious burden. The claims of the instant application are united by the single inventive concept of identifying and using compounds that mimic or bind to FIH. The chemical entities of claim 7-25 are identified by the method of the claims 1, 3-6, and 29-33, and then administered to patients as a method of treatment of claims 27-28. Since these inventions are capable of use together, they are not unrelated, and there would not be a serious burden on the examiner to search divergent subject matter. Accordingly, Applicants request that the restriction requirement be withdrawn. However, to be fully responsive, Applicants, with traverse, elect Group I.

If the Examiner chooses to maintain the restriction requirement, and should the restricted claims be found allowable, Applicants expect the Examiner to continue to examine the full scope of the claimed subject matter to the extent necessary to determine the full scope of the patentability thereof, *i.e.*, extending the search to the claims of Groups II and III, as is the duty of the Examiner according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

The Examiner has also indicated that claims to the chemical entities are directed to more than one species of the generic invention. Office Action at 3. The Examiner believes that the species lack unity of invention. *Id.* None of the claims of selected

Group I are chemical entities. Rather, the claims in Group II are directed to chemical entities. Therefore, Applicants do not believe that it is necessary to respond to the species election requirement at this point, and the species requirement is not relevant.

In summary, Applicants respectfully traverse the restriction requirement. However, to be fully responsive, Applicants elect Group I.


If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, the Examiner is invited to call the undersigned at (202) 408-4162.

If there is any fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: May 21, 2007

By: 

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